

REMARKS

Favorable reconsideration and allowance of the claims pending herein are requested.

By way of the amendment instructions above, an appropriate cross-reference to the applicants' now abandoned parent application Serial No. 09/987,330 has been inserted on page 1. It is further noted that the specification amendment to page 2 which was previously proposed via the Preliminary Amendment of June 23, 2003, was in error and should be disregarded.

A title more commensurate with the subject matter claimed herein has also been proposed above.

Claims 5-8 as submitted with the Preliminary Amendment of June 23, 2003 remain pending herein. As will become evident from the discussion which follows, all pending claims are in condition for allowance.

Pending claims 5-8 attracted a rejection under 35 USC §103(a) as allegedly being "obvious", and hence unpatentable over Nakagawa (USP 4,020,481) in view of Dröscher et al (USP 4,731,413) or vice versa. Applicants respectfully disagree.

In this regard, applicants note that the present invention is novel in that increased protection, fluid sealing and the like may be afforded to such bulbs associated with reed switches by means of the bulb being embedded entirely within an injection molded body portion formed of a hot melt adhesive resin. Significantly, the hot melt adhesive resin has an injection molding temperature within the range of 180°C to 220°C and an injection molding pressure of 3 to 35 Kg/cm². Because of such physical attributes, the bulb of the reed switch, except for the exposed portions of the terminals electrically connected to the leads within the bulb, may be encased entirely within the hot melt resin providing superior protection thereof.

The applied Nakagawa reference merely discloses a reed switch which is physically within an essentially ***hollow*** tube or cylinder 7. The applied Nakagawa reference therefore fails to disclose or even remotely suggest the present invention as defined in the claims presented herewith. Particularly, Nakagawa fails to suggest at all the desirability of encasing a bulb unit within *any* resin -- let alone the ***particular hot*** melt adhesive resin defined in applicants' pending claims -- as Nakagawa incorporates a conventional reed switch within an inner cylinder 7. Indeed, Nakagawa suggests that the cylinder 7 must be open-ended and sealed by means of the grommet 25 through which the lead lines protrude.

The applied Dröscher et al reference is totally silent with regard to the employing the therein disclosed resin to encase a bulb of a reed switch in the manner defined in the presently pending claims. While Dröscher et al mention with a very broad statement that the therein disclosed resins may be usefully employed in the "...automotive, electrical or the electronic sector", there clearly is no impetus given to the ordinarily skilled person to employ the Dröscher et al resin in the ***particular*** manner as defined in the present claims.

With all respect due to the Examiner, the rejection at issue here has apparently been made in the impermissible glare of hindsight since no suggestion or motivation at all to accomplish what the present applicants have done exists in either of the applied references of record.¹

The Federal Circuit has consistently and uniformly held that in order to be a *prima facie* case of obviousness there must have been a suggestion that is clear from the prior art itself for a modification or combination to provide a claimed invention. For

¹ The Federal Circuit regards hindsight as an insidious and powerful phenomenon and is a tempting, but forbidden zone in the inquiry of addressing the statutory obviousness standard. See, e.g., *Panduit Corp. v. Dennison Mfg. Co.*, 227 USPQ 337 (Fed. Cir. 1985) and *Loctite Corp. v. Ultraseal Ltd.*, 228 USPQ 90, 98 (Fed. Cir. 1985).

example, see the very clear decision in the case of *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991):

"Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under §103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. Id." (Emphasis added.)

It must therefore be appreciated that in holding an invention obvious in view of a "combination" of art, there must have been some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to have selected the "references" and combined them in a way that would have produced the claimed invention. See, e.g., *Heidelberger, Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); *Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 1434, 1438 (Fed. Cir. 1988).

As noted above, there is no suggestion or appreciation at all in the either the applied Nakagawa et al or Dröscher et al references which would lead an ordinarily skilled person to the presently claimed invention.

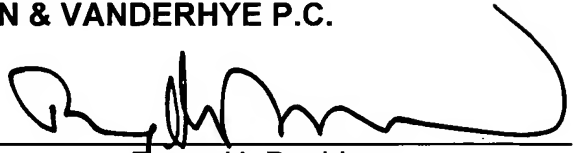
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The Examiner has therefore failed to establish a *prima facie* case of obviousness. As such, the rejection advanced under 35 USC §103(a) must be withdrawn. Such favorable action is solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Bryan H. Davidson
Reg. No. 30,251

BHD:bcf
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100